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October 19, 2015

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United States Patent and Trademark Office
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**Attention: Lead Judge Susan Mitchell
Patent Trial Proposed Rules**

Re: Comments of the ABA Section of Intellectual Property in
Response to the USPTO's Proposed Rules on Trial Proceedings
Under the America Invents Act Before the Patent Trial and Appeal
Board [Docket No. PT0-P-2015-0053; Fed. Reg. Vol. 80, No. 161,
pages 50720-50747]

Dear Lead Judge Mitchell:

The ABA Section of Intellectual Property Law ("ABA-IPL Section" or "Section") thanks the United States Patent and Trademark Office ("USPTO") for the opportunity to comment on the USPTO's Request for Comments on Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board ("PTAB" or "Board"). These comments are presented on behalf of the ABA-IPL Section. They have not been approved by the House of Delegates or the Board of Governors of the American Bar Association ("ABA") and, accordingly, should not be construed as representing the position of the ABA.

The ABA is the leading national voluntary bar organization of the legal profession, having nearly 400,000 members. Its members come from each of the fifty states, the District of Columbia, and the U.S. territories. Membership includes attorneys in private practice, government service, corporate law departments, and public interest organizations, as well as legislators, law professors, law students, and non-lawyer associates in related fields. The IPL Section is the world's largest organization of intellectual property professionals, with approximately 20,000 members.

The ABA-IPL Section appreciates the USPTO's efforts to further improve the trial proceedings under the America Invents Act ("AIA") and invitation for public comment in response to the questions posed.

CLAIM CONSTRUCTION STANDARD

The USPTO solicited comments for the following three questions: (1) should the USPTO set forth guidelines where a petitioner may determine, prior to filing a petition, which claim construction standard will be applied by the USPTO based on the relevant facts; (2) should a petitioner that believes the subject patent claims will expire prior to issuance of a final written decision be required to submit claim interpretation analysis under both *Phillips*-type and broadest reasonable interpretation (“BRI”) approaches to claim construction or state either approach yields the same result; and (3) should the USPTO allow briefing after the filing of a petition but before a patent owner’s preliminary response is filed concerning which claim construction standard should be employed?

At the outset, the ABA-IPL Section believes a *Phillips* construction should apply if there is *no* reasonable opportunity to amend the claims. *See Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005). Under existing rules, the PTAB has not provided patent owners with a reasonable opportunity to amend. In contrast to *inter partes* reexamination, where a patent owner has the right to offer any number of new claims so long as they are no broader than the patented claims, in post grant proceedings the patent owner must explain to the PTAB’s satisfaction why each of the new claims are patentable over all prior art of record.¹ Thus, current PTAB rules do not provide patent owners with a reasonable opportunity to amend, as evidenced by the fact that in only a very few of these trials has the PTAB granted requests to amend. Accordingly, the ABA-IPL Section respectfully submits that the USPTO should reconsider its position on claim construction and adopt the *Phillips* approach to claim construction in AIA trial proceedings.

The Section believes the USPTO should promulgate clear rules regarding the claim construction standard to be used in an AIA proceeding so that petitioners have certainty regarding claim construction prior to the filing of a petition. This will provide petitioners necessary information when considering whether and/or when to challenge claims in an *inter partes* review (“IPR”) and other AIA post-issuance proceedings.

The Section believes that petitioners should not be required to submit both BRI and *Phillips* claim constructions in a petition. Such a requirement imposes both a burden and uncertainty on petitioners and patent owners alike.

Finally, should the USPTO continue its practice of applying different claim construction standards based on the expiration date of the patent, the ABA-IPL Section believes the USPTO should allow for additional briefing concerning which standard should be applied after the filing of a petition but before a patent owner’s preliminary response is filed, as circumstances require.

¹ See comments on Motion to Amend below for an analysis of what constitutes a reasonable opportunity to amend.

MOTION TO AMEND

The ABA-IPL Section encourages the USPTO to lower the burden on patent owners for Motions to Amend and applauds the USPTO's recent efforts in this regard. The Section believes that the USPTO should continue to make claim amendments more permissive and reduce the burden on patent owners of proving the patentability of any proposed amended claim.

The USPTO's Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board (or "Interim Rule Change") issued in May 2015, increased the page limit of Motions to Amend from 15 to 25 pages and permitted a claims appendix in a Motion to Amend. *See* 80 Fed. Reg. 28561-566 (May 19, 2015) (to be codified at 37 C.F.R. Part 42). The IPL Section believes that these changes are a step in the right direction.

The Board's decision in *MasterImage 3D, Inc. v. RealD, Inc.*, IPR2015-00040, Paper 42 (July 15, 2015) also goes in the right direction by limiting the universe of potential prior art over which the patent owner has to show patentable distinction of the amended claims. In *MasterImage 3D*, the Board clarified that the "prior art of record" refers to (1) the prior art of record (*i.e.*, all material art in the prosecution history of the patent, all material art in the current proceeding, including art from grounds not instituted, and material art of record in any other proceeding before the USPTO involving the patent) and (2) the prior art known to the patent owner (the material prior art that the patent owner makes of record in the proceeding pursuant to its duty of candor and good faith to the USPTO under 37 C.F.R. § 42.11, in light of a Motion to Amend, which presumably includes all prior art brought to the patent owner's attention in any Court proceeding related to the patent in question).

Nevertheless, the current motion to amend practice is still ineffective. The current practice:

- promotes inefficiency by all but forcing at least one parallel *ex parte* proceeding to enable the patent owner to amend claims, thereby creating confusion inherent to multiple proceedings and preventing a "just, speedy, and inexpensive resolution" of the controversy between the parties. *See* 37 C.F.R. 42.1(b);
- establishes an often impossible burden for the patent owner to overcome within the AIA post-grant proceeding in many circumstances, particularly in circumstances where many documents have been asserted against the subject patent over time;
- improperly shifts too much of an unnecessary burden of persuasion onto the patent owner;
- creates an unnecessary burden on the PTAB to consider arguments about prior art that the petitioner did not assert or that the PTAB decided did not warrant

institution of trial because they were redundant or did not rise to the level of establishing a likelihood of success; and

- increases confusion, in that *MasterImage* seems to require a heightened effort by the patent owner to address prior art brought before the USPTO in any proceeding as opposed to prior art that the patent owner might be aware of through a different avenue.

The ABA-IPL Section urges the USPTO to lower the burden on patent owners. Specifically, patent owners should have the burden to establish a *prima facie* case of patentability of the narrower substitute claims only *over the grounds upon which the trial phase was initiated*.

This proposal alleviates the need for a patent owner-initiated parallel *ex parte* reexamination or reissue proceeding, particularly in circumstances when the proposed claim amendments clarify the claims in a way that supports the patent owner's interpretation of the claims or removes at least one of the grounds of unpatentability asserted by the petitioner.

This proposal is consistent with the often-stated proposition that a post-grant trial is not an examination process. Sections 35 U.S.C. § 316(d), 35 U.S.C. § 326(d), and 42 C.F.R. § 1.21(a)(3) fairly suggest that AIA post-grant proceedings are not designed to make absolute determinations of patentability and are not an examination process, and none requires the heightened burden of persuasion identified in *Idle Free (Idle Free Systems, Inc. v. Bergstrom, Inc., IPR2012-00027, Paper 26 (June 11, 2013) (informative) and MasterImage3D*.

This proposal does not compromise the integrity of the proceedings with respect to substantive issues, timing, or procedure.

Lastly, this proposal promotes PTAB efficiency by not requiring consideration of prior art that the petitioner might not consider as establishing unpatentability. The petitioner has an opportunity to “explain why patent owner did not make out a *prima facie* case of patentability, or attempt to rebut that *prima facie* case, by addressing patent owner's evidence and arguments and/or by identifying and applying additional prior art against proposed substitute claims.” *MasterImage*, IPR2012-00027, at 4. The patent owner then has a chance to reply. The net result being that the PTAB only has to consider the prior art in controversy, rather than a potentially large number of prior art references.

This proposal does not change the ultimate burden of persuasion on the patent owner to demonstrate the patentability of the narrower substitute claims.

PATENT OWNER PRELIMINARY RESPONSE

The ABA-IPL Section disagrees with the proposal to allow patent owners to submit new testimonial evidence prior to the institution of a trial. This proposal, which would allow patent owners to submit new testimony before institution that is not subject to cross-examination, unfairly prejudices petitioners who have no means of appeal should

the PTAB decide not to institute the trial. In the alternative, should the USPTO decide to implement this rule change, petitioners should be given an opportunity to respond to the new testimony prior to the decision to institute.

The Section is concerned that PTAB panels, despite being directed to resolve factual disputes in favor of petitioners, will not be able to do so after having considered the new uncontested testimonial evidence prior to institution. This prejudices petitioners who have no opportunity to cross-examine the witnesses and have no effective appeal from a decision not to institute. On the other hand, should institution occur, the patent owner will have a full opportunity to submit new testimony during the trial proceedings and to challenge the merits of the decision to institute both during the trial proceedings and on appeal to the Federal Circuit.

ADDITIONAL DISCOVERY

The ABA-IPL Section agrees that the PTAB should maintain a high standard for granting discovery, which should be decided on a case-by-case basis.

The USPTO has declined to adopt a mandatory rule regarding discovery of secondary considerations, and proposes that the PTAB continue to rely on the *Garmin* factors, which it believes currently provide appropriate and sufficient guidance on handling requests for additional discovery, which the PTAB will continue to decide on a case-by-case basis. *See* 80 Fed. Reg. 50720, 50728 (Aug. 20, 2015). The Section agrees with this approach.

The USPTO rules allow for additional discovery during the course of an IPR proceeding, pursuant to 37 C.F.R. § 42.51, which reads in pertinent part as follows:

- (b) *Limited discovery.* A party is not entitled to discovery except as provided in paragraph (a) of this section, or as otherwise authorized in this subpart
- (2) *Additional discovery.*

- (i) The parties may agree to additional discovery between themselves. Where the parties fail to agree, a party may move for additional discovery. The moving party must show that such additional discovery is in the interests of justice, except in post-grant reviews where additional discovery is limited to evidence directly related to factual assertions advanced by either party in the proceeding (*see* § 42.224). The Board may specify conditions for such additional discovery.

The test that is applied in determining whether additional discovery is allowable pursuant to this rule is set forth in *Garmin v. Cuozzo*, IPR2012-00001, Paper No. 26, at 5 (March 5, 2013), which provides five factors that must be considered:

- more than a possibility and mere allegation;
- litigation positions and underlying basis;

- ability to generate equivalent information by other means;
- easily understandable instructions; and
- requests not overly burdensome to answer.

The above rule and five-factor test should permit a patent owner to obtain additional discovery from a petitioner if the patent owner has demonstrated that the petitioner is reasonably likely to possess evidence of secondary considerations of nonobviousness, for example, if the patent owner has demonstrated that the petitioner sells a commercial product meeting each of the limitations of a challenged claim and where the discovery requests are of reasonable scope. Highly targeted and limited discovery requests will ensure that the discovery is not overly burdensome.

The PTAB should allow the patent owner to obtain from the petitioner limited discovery of evidence of secondary considerations of non-obviousness, such as commercial success, where patent owner can make a good-faith argument that there is a nexus between such evidence and the claimed invention, or if the patent owner can demonstrate that the petitioner is reasonably likely to possess evidence of secondary considerations of non-obviousness. These threshold requirements could be satisfied, respectively, with evidence of infringement contentions offered in corresponding district court litigation for that purpose, or where the patent owner has demonstrated that the petitioner sells a commercial product meeting each limitation of a challenged claim. In each instance, the discovery requests should be of reasonable scope.

The Section agrees that to require proof of the nexus between secondary considerations evidence and the claimed invention before authorizing additional discovery would place too high a burden on the patent owner. Nonetheless, some showing of nexus should be required to ensure that the additional discovery is necessary in the interest of justice or is supported by good cause. Further, the burden of establishing that nexus would still remain on the patent owner after such additional discovery is authorized. The additional discovery should be limited in scope, *e.g.*, to summary sales figure information, and could be subject to confidentiality limitations.

Highly targeted and limited discovery requests, which are reasonable in scope, will ensure that the additional discovery is not overly burdensome and can be timely completed. The Section agrees with the USPTO that the mere possibility of finding something useful through additional discovery, as well as the mere allegation that something useful will be found, should be insufficient to demonstrate that the requested additional discovery is necessary in the interest of justice. Thus, additional discovery should be denied unless a patent owner is able to present a threshold amount of evidence or reasoning tending to show beyond speculation that something useful will be uncovered.

Finally, the ABA-IPL Section agrees with the USPTO that the parties should work together early in the case in an attempt to reach agreement on information exchange and possible initial disclosures, which may include information regarding secondary indicia of non-obviousness.

REAL PARTY-IN-INTEREST

The ABA-IPL Section believes that a patent owner should be able to raise a challenge regarding a real party-in-interest (“RPI”) at any time during a trial if the patent owner can demonstrate that it did not delay in presenting the challenge while in possession of the information necessary to raise the challenge. Specifically, a patent owner should be permitted to raise a RPI challenge after institution of the trial if:

- the patent owner demonstrates sufficiently that (a) it did not delay in presenting the challenge while it knew or should have known of the information necessary to raise the challenge, (b) it was not previously aware of facts that would raise doubt as to whether the petition correctly named all RPIs, and (c) in the event patent owner relies on information obtained in discovery after institution, that the patent owner did not delay in requesting discovery prior to institution based on information it knew or should have known;
- the petitioner has a right to demonstrate any facts that would counter patent owner’s argument that it did not delay in submitting the challenge or requesting discovery after institution; and
- the burden of proof in establishing that the petitioner’s RPI identification is incorrect lies with the patent owner.

The Section also believes that the PTAB should permit a petitioner to amend its RPI designation without loss of filing date (which loss often leads to dismissal), when allowing such an amendment would be in the interests of justice. The Office Patent Trial Practice Guide (“Trial Practice Guide”) states that the “core functions of the ‘real party-in-interest’ and ‘privies’ requirement [are] to assist members of the Board in identifying potential conflicts, and to assure proper application of the statutory estoppel provisions.” 77 Fed. Reg. at 48759. The Trial Practice Guide also states that the rules of AIA trials “are to be construed so as to ensure the just, speedy, and inexpensive resolution of a proceeding.” 77 Fed. Reg. at 48758. However, in practice, the PTAB has, in numerous proceedings, permitted patent owners to raise late RPI challenges that resulted in the dismissal of proceedings, long after institution. In such cases, the result is that claims which the PTAB determined to be likely unpatentable are maintained due to a procedural requirement that does not touch the merits of the proceeding, which is contrary to the interests of justice.

The Trial Practice Guide also states that whether a party not named in an AIA trial is a “real party-in-interest” or “privy” is a “highly fact-dependent question,” taking into account various factors such as whether the non-party “exercised or could have exercised control over a party’s participation in a proceeding” and “the degree to which a non-party funds, directs, and controls the proceeding.” Trial Practice Guide, 77 Fed. Reg. 48756, 48759-60 (Aug. 14, 2012). Different panels of the PTAB considering this issue have reached different conclusions involving similar factual scenarios. If a petitioner has a reasonable basis for not identifying a particular party in its petition and that party is later determined to be a RPI under the panel’s consideration of the “highly fact-

dependent question,” then the PTAB should, when the interests of justice warrant and in the absence of fraud, permit a petitioner to amend its RPI designation without loss of filing date.

MULTIPLE PROCEEDINGS

The ABA-IPL Section believes it appropriate to coordinate separate AIA trials on the same patent by consolidating the trials before the same panel. If statutory time constraints permit, the Section suggests that separate trials move forward with parallel dates. The Section does not believe it is practical to coordinate *ex parte* proceedings with AIA trials due to the statutory time constraints of AIA trials. However, a stay of an *ex parte* proceeding should be considered when the outcome of an instituted AIA trial may impact the outcome of the *ex parte* proceeding.

Duplicative USPTO proceedings thwart the goal of reducing the expense and burden of implementing multiple patentability disputes that could be resolved in a single proceeding in a single forum. The burden on patent owners facing multiple or concurrent AIA trials, reexamination proceedings, and/or reissue proceedings (and potentially litigation in district court) is enormous, and the USPTO should implement procedures that will alleviate the burden where possible.

A putative infringer often has the opportunity, and chooses, to file more than one PGR, IPR, CBM review, and/or reexamination of the same patent, with very little procedural threshold for pursuing one, some, or all of these proceedings. At the present time, the rules governing AIA post-grant proceedings insufficiently protect patent owners from potential harassment through multiple proceedings (AIA post-grant proceedings, and *ex parte* reexaminations). Further, the current position of the USPTO on the effect one proceeding has on another promotes inefficiency and often prevents the PTAB from achieving its primary goal of securing a “just, speedy, and inexpensive resolution” of the controversy between the parties. 37 C.F.R. § 42.1(b).

The Central Reexamination Unit (“CRU”) does not view prior PTAB decisions on the same patent, same claims and/or same prior art as binding or inhibiting the CRU from construing the claims and/or interpreting the same prior art in a manner that is inconsistent or even directly at odds with the PTABs earlier decisions (whether a decision declining to institute a post-grant proceeding or a final written decision). The CRU seems to adhere to PTAB decisions only when its actions are appealed to the PTAB and the CRU is reversed, and then only with respect to the specific grounds for reversal.

The USPTO declined to adopt “horizontal stare decisis” as effectively abolishing the Board’s discretion, in 80 Fed. Reg. 50734-35 (Aug. 20, 2015). The USPTO’s comments did not extend to “vertical stare decisis” as to actions by the subordinate CRU after a PTAB decision.

At present, the ability of each tribunal, whether the same or a different panel at the PTAB or a panel of *ex parte* examiners in the CRU, to effectively ignore and not even address prior decisions of another panel has the effect of:

- creating uncertainty regarding the meaning of claim terms, relevance of prior art, and/or patentability of claims;
- reducing the chances of a final resolution of controversies between the parties;
- reducing the ability of the market to be on notice as to what the patent owner's rights are; and
- promoting multiple parallel and/or serial proceedings often on nearly the same grounds.

In short, there are too many ways, too many forums, and too many opportunities to have a patent declared unpatentable, creating an imbalance between patent owners and putative infringers.

As a modest and logical proposal, the USPTO should adopt a practice or rule that effectively increases the threshold for the USPTO to take inconsistent positions as to (1) claim term interpretation, (2) the status of a document as prior art, and (3) interpretations of prior art relative to relevant claim terms that have been explicitly or implicitly construed by the earlier panel. This could be done by any number of procedural mechanisms including one or more of, but not limited to, the following:

- in a final written decision or decision denying institution, ordering other panels, whether at the PTAB or the CRU, not to take an inconsistent position without crossing a defined procedural threshold;
- adopting Rules that create an equivalent threshold; and/or
- adopting publically available, internal procedures that create an equivalent threshold.

The procedural thresholds could be one or more of:

- requiring petitioners in later post-grant proceedings and *ex parte* reexamination requestors, and the patent owner, to identify and explain why the later panel should adopt an inconsistent position;
- requiring a later panel to address the earlier panel's position, explain why it is adopting an inconsistent position by identifying new facts or changes in the law that (1) could not have been reasonably raised in the earlier proceeding of the same party and (2) by a preponderance of the evidence undermine the earlier PTAB panel's ruling (making it clear a mere disagreement by the later panel on the same claims, prior art or other facts is not sufficient). This would be akin to the standard under 37 C.F.R. § 42.71(d) (requiring a party seeking rehearing to identify all matters the party believes the Board misapprehended or overlooked), but provides greater flexibility that might be appropriate when the parties are different or there are additional facts to consider;

- seeking supervisory review by the Director of the USPTO or the Chief Judge of the PTAB, or other sufficiently high ranking officer at the USPTO, before publically taking an inconsistent position; and/or
- other procedural thresholds that limit the later panel’s ability to arbitrarily adopt a view different from the earlier panel.

This approach would not add significantly to the burden on the patent challengers or the USPTO, but would provide clarity of record, promote certainty and finality of decisions by the USPTO, and reduce the specter of the USPTO taking inconsistent positions as to claims that should be interpreted under the same standard (BRI in most instances). In addition, this approach would reduce motivations on the part of patent challengers to file multiple and often overlapping or duplicative filings on the merits in the same or different forums or under the same or different proceedings, thereby reducing the burden on the USPTO and the patent owner while further assuring a “just, speedy and inexpensive resolution” of the controversy and any further proceedings.

EXTENSION OF 1 YEAR PERIOD TO ISSUE FINAL DETERMINATION

The ABA-IPL Section believes that there should remain a high bar for establishing “good cause” to extend the 1-year period for the Board to issue a final determination in an AIA trial.

IPR proceedings were intended to provide a quick and efficient resolution to questions of patentability. As such, proceedings are to be completed within one year, except in limited circumstances where the time period is extended to 18 months.

To that end, 37 C.F.R. § 42.100(c) states

An inter partes review proceeding shall be administered such that pendency before the Board after institution is normally no more than one year. The time can be extended by up to six months for good cause by the Chief Administrative Patent Judge, or adjusted by the Board in the case of joinder.

The Section believes the USPTO should continue to strictly adhere to the one-year period and rarely grant extensions of time except for good cause as proscribed by statute. This preserves Congress’s intent for creating an IPR as a speedy alternative to district court litigation. The IPL Section supports the USPTO’s intent to revise the Trial Practice Guide to provide examples where an extension of the one-year statutory period may be warranted. The Section asks that the USPTO provide an explanation with the examples as to why good cause was shown.

The Section submits that good cause for extending the statutory period may exist when one of the parties is prejudiced by circumstances that are unforeseeable and outside of its control, provided the other party agrees to the extension of time.

The Section also agrees that, in at least some instances, the “complex” cases identified in the Proposed Rules (*e.g.*, consolidation or joinder of multiple proceedings trials) may

constitute “good cause” for the PTAB’s exercise of discretion to extend the pendency of an IPR up to six months.

ORAL HEARING

The ABA-IPL Section agrees that the PTAB should continue its present practice of considering allowing live testimony at the oral hearing where either party requests it or where the issues to be decided turn upon conflicting testimony.

Live testimony is one of the hallmarks of the common law justice system. It is integral to issues of credibility and weighing of evidence. And because the stakes in some of the PTAB’s post-grant proceedings are exceedingly high (millions or even billions of dollars), the parties should be allowed the opportunity to present live testimony if desired.

The Section agrees that no changes should be made to the format of the oral hearing, which is generally left to the discretion of the panel.

The Section believes that the parties should be limited to presenting argument on issues specified in the oral hearing request. Currently, parties must submit a request for oral hearing if such oral hearing is desired, wherein the request “must specify the issues to be argued.” *See* 37 C.F.R. § 42.70. Such rule does not specify whether the oral argument must be limited to the issues identified in the request. The Section agrees that guidance on this issue in the FAQs on the PTAB Trials Website and in the Trial Practice Guide is warranted.

The Section agrees that the parties should be provided with additional time before the hearing to permit exchange and conference on demonstratives.

The Section agrees that all Patent Judges presiding over a proceeding should be available for an oral argument over multiple sessions, *e.g.*, in proceedings involving consolidated IPRs. While the hearing transcript is available to the PTAB after the hearing, parties typically have considerable interaction with the PTAB during the hearing. Having all involved Judges present at all sessions would allow for a more productive hearing.

USING A WORD COUNT LIMIT INSTEAD OF A PAGE LIMIT

The Section supports using a word count limit over a page limit. The Section also, however, favors allowing litigants an additional 2,000 words beyond the proposed limit.

Word count limits provide the parties more flexibility than page limits to present their arguments in the most effective and organized format. This will promote efficiency and better advocacy before the PTAB. Implementing a word count limit will also simplify the PTAB’s enforcement of the rules as the parties will be required to certify compliance and attempts to circumvent page limitations such as skirting spacing or margin requirements will not be possible.

To simplify compliance with the word count limit further, the USPTO should consider requiring that mandatory notices be submitted as an addendum to the petition instead of being incorporated into the petition. This will promote focus on substantive arguments. Because the number of parties and related proceedings can be significant in certain cases, exempting mandatory notices from the word count limitation will also promote fairness. The Section notes that the Federal Circuit and other courts have long used word count limits successfully.

RULE 11-TYPE CERTIFICATION

The proposed rules would introduce a new requirement on practitioners before the PTAB, akin to the Rule 11 requirements in federal courts, to give the USPTO a more robust means with which to police misconduct.

The ABA-IPL Section does not believe that this proposal is necessary or warranted.

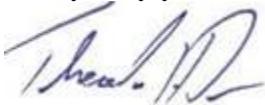
The PTAB has the discretion to impose sanctions against a party and its counsel under 37 C.F.R. § 42.12. By submitting papers with the PTAB, a party and its counsel of record understand that they must comport with the duty of candor under 37 C.F.R. § 42.11. If the PTAB believes that a party, or counsel of the party, is not comporting with its duty of candor, then the PTAB may impose appropriate sanctions, including referral of any misconduct to the Office of Enrollment and Discipline (OED) for appropriate review.

CONCLUSION

In closing, the ABA-IPL Section recognizes and appreciates the USPTO's efforts to solicit public opinions regarding PTAB trial proceedings and offers the foregoing comments in an effort to help the USPTO implement rules that best serve the interests of the users of the patent system and the public.

If you have any questions on our comments or would wish for us to further explain any of our comments, please feel free to contact me. Either I or another member of the leadership of the ABA-IPL Section will respond to any inquiry.

Very truly yours,



Theodore H. Davis Jr.
Section Chair
American Bar Association
Section of Intellectual Property Law